

PRECEDENT CITATIONS:

The below remarks specifically point out certain case citations, where relevant. It is respectfully noted that the precedent set forth in these cases is binding on both the applicant and the Examiner. "It is well established that agencies have a duty to provide reviewing courts with a sufficient explanation for their decisions so that those decisions may be judged against the relevant statutory standards, and that failure to provide such an explanation is grounds for striking down the action," in addition, **"an agency is not free to refuse to follow circuit precedent."** In re Lee 61 USPQ2d 1430, 1434 (CA FC 2002). (Emphasis added).

Thus, it is respectfully submitted that rejections based on improper rationale thereby fail to meet a required prima facie obviousness standard. ✓

REQUEST FOR NEW OFFICE ACTION:

As noted below, at least the rejection of claims 3, 4 and 15 are based on an improper "merely a duplication of parts" rationale. Particular court precedent has been provided, which specifically indicates that such a rationale for rejecting/invalidating claims is improper in an obviousness reasoning.

The rejection of claims 3, 4 and 15 is improper, and a new Office Action is requested. ✓

OBJECTION TO THE TITLE:

The Office Action has objected to the title since the term "hologram," or the phrase "pickup having a holographic lens element," is not specifically recited. However, it is noted that the title is representative of the claims of an application, not any particular inventive feature that may be disclosed in the application. Applicant should not be limited to using the term "holographic lens element." Further, the independent claims may not require the "holographic lens element" term, and are thereby broader than the same.

Withdrawal of this objection is respectfully requested.

REJECTION UNDER 35 U.S.C. §103:

Claims 1, 2, 6, 7, 13, 14 and 16 stand rejected under 35 U.S.C. §103(a) as being obvious over the acknowledged prior art (Prior Art) (either Figure 1 or 2 as submitted) in view of Maeda et al., U.S. Patent No. 5,303,221. This rejection is respectfully traversed.

Independent claims 1 and 13 set forth particularly claimed features that are not in either Prior Art or Maeda et al.

Prior Art merely illustrates a single light source pick-up.

Maeda et al. sets forth an optical pickup using two different wavelength light beams, from a single laser light source, to read from two different types of mediums. Specifically, light from a single light source is separated into two different wavelength light beams. Since collimator lens 4a and objective lens 5a generate aberration, hologram 11 is used to add negative spherical aberration to the longer wavelength light beam, primarily since spherical aberration increases with longer wavelengths.

Specifically, "the beams of the blue light are focused on the disc 6 at a predetermined spot diameter of the designed diffraction limited performance, because the wave front of the blue light is not converted by the phase hologram 11. The beams of the infrared rays are focused on the disc also at a desired spot diameter of the diffraction limited performance because of the aberration correction at the phase hologram 11." Maeda et al. at col. 3, lines 50-57.

Upon reflecting off of the medium, the two light beams of differing wavelength are detected at different positions on detector 10. See Maeda et al. at col. 4, lines 13-17.

Thus, in Maeda et al., the light detector is "optimized for" detecting both light beams.

Therefore, Prior Art and Maeda et al. at least fail to disclose "an optical detector detecting the first and second laser beams transmitted from the optical system, the optical detector being optimized with respect to the second laser beam...and an optical converter converting the first laser beam transmitted from the optical system into the laser beam detectable by the optical detector." (Emphasis added).

The Office Action states that "[w]ith respect to the phrase 'optimized with respect to the second laser' as a description of the detector, this is believed to occur from the above combination of elements, e.g., the photodetector in Maeda et al. is now optimized for a second

laser beam."

Essentially, the Office Action is stating that if all the aforementioned features were combined, then the Examiner "believes" that such a combination would thereby meet the additional claim features.

This rationale is contrary to any required prima facie obviousness standard. It is improper to force elements together and then infer from their combination that additional claimed features probably must thereby be met.

Regarding rationale for combining Prior Art and Maeda et al., the Office Action recites: [i]t would have been obvious to modify [Prior Art] with the additional teachings of Maeda et al. *to provide for separate laser light sources at [different] wavelengths, motivation is to provide for a dual wavelength optical [pick-up] device.*"

It is respectfully submitted that this rationale is improper.

An Office Action rejection of a claim is required to establish a prima facie case of obviousness based upon the prior art..."[An Examiner] can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would **lead** that individual to combine the relevant teachings of the references." In re Fritch, 23 USPQ 2d 1780, 1783 (Fed. Cir. 1992).

"Rejection of patent application for obviousness under 35 U.S.C. §103 must be based on evidence comprehended by language of that section, and search for and analysis of prior art includes evidence relevant to finding of whether there is teaching, motivation, or suggestion to select and combine references relied on as evidence of obviousness; factual inquiry whether to combine references must be thorough and searching, **based on objective evidence of record.**" In re Lee 61 USPQ2d 1430 (CA FC 2002)(vacating a decision by The Board of Patent Appeals and Interferences ("Board") of the USPTO, which upheld an examiner's rejection where the motivation for a specific combination was not supported by the record; the vacated holding of Board was based on the premise that "[t]he conclusion of obviousness may be made from common knowledge and common sense of a person of ordinary skill in the art without any specific hint or suggestion in a particular reference.")(Emphasis added).

Thus, accordingly, a prima facie obviousness rejection requires evidenced motivation from some reference in the record that would lead one skilled in the art to combine the relevant teachings, again noting that the mere fact that the prior art may be modified in a particular

manner does not make the modification obvious unless the prior art suggested the desirability of that modification.

In contradiction, the Office Action has merely set forth that particularly claimed features may be disclosed by either Prior Art or Maeda et al., and thereafter states [i]t would have been obvious to modify [Prior Art] with the additional teachings of Maeda et al. *to provide for separate laser light sources at [different] wavelengths, motivation is to provide for a dual wavelength optical [pick-up] device."*

Nowhere, but in the present application, does the record provide any motivation for combining Prior Art and Maeda et al., especially to combine the two to disclose the particularly claimed features. The mere fact that the prior art may be modified in the manner suggested in the Office Action does not make the modification obvious unless the prior art suggested the desirability of the modification. In re Fritch at 1783-84

Thus, for at least the above, it is respectfully requested that this rejection be withdrawn.

Claims 3, 4 and 15 stand rejected under 35 USC §103 as being obvious over Prior Art and Maeda et al. This rejection is respectfully traversed.

In rejecting claims 3, 4 and 15, the Office Action indicates that although the Prior Art and Maeda et al. fail to disclose multiple collimating lenses, the use of two collimating lenses would have been obvious since it would have been merely a "duplication of parts."

As previously pointed out, a prima facie obviousness rejection requires both indications where a claimed feature can be found in the prior art and where particular motivation, for incorporating the same in the proffered combination, can be found.

This "merely a duplication of a single part " rationale is improper. The impropriety of this reasoning is more fully discussed in the following case citation:

"the [lower] court came to the conclusion that 'The inquiry is whether two lines of adhesive, both of which penetrate the napkin and seal the cover as opposed to only one penetrating and sealing the cover, is a non-obvious invention.' At the outset, that is a misstatement of the issue, which is whether the subject matter claimed would have been obvious, at the time of Roeder's invention, to one of ordinary skill in the art." *Kimberly-Clark Corporation v. Johnson & Johnson and Personal Products Company*, 223 USPQ 603, 609 (CAFC 1984). "The proper approach to the obviousness issue must start with the claimed invention as a whole. 35 U.S.C. § 103... It is true that it consists of a combination of old

elements so arranged as to perform certain related functions. It is immaterial to the issue, however, that all of the elements were old in other contexts. What must be found obvious to defeat the patent is the claimed combination...The invention which we find non-obvious is, however, that which is specifically claimed in the patent in suit, a narrow invention in a crowded art. The holding of invalidity on the ground of obviousness is therefore reversed." *Id.*

Thus, the use of a "merely duplication of parts" rationale is improper for substantiating an obviousness rejection.

Independent claims 3, 4 and 15 set forth particular features, which are not disclosed in either Prior Art or Maeda et al. It is irrelevant that particular claimed features may exist separately. What is necessary is that the claim as a whole be obvious. There must be some motivation for making such a combination or modification.

Claims 5 and 8-11 stand rejected under 35 U.S.C. §103(a) as being obvious over the art as applied to claim 4 above, and further in view of Kajiyama et al., U.S. Patent No. 6,181,668. This rejection is respectfully traversed.

It is respectfully submitted that claim 5 and 8-11 are at least allowable for depending from allowable base claims.

In addition, regarding claim 5, the Office Action states that "[t]he examiner concludes that such an angle is optimization ability within the skill of the artisan - in manufacturing of collimating lenses, and such would entail routine ability to modify the collimating lens in the above references so as to impart a particular desired angular divergence of the beam."

Essentially, the Office Action is indicating that the particularly claimed features would have been obvious since the Examiner "believes" someone in the art would have modified the collimating lenses "to impart a particular desired angular divergence of the beam."

As noted above, and as noted previously, it is irrelevant what the Examiner "believes."

To set forth a prima facie obviousness rejection, the Office Action must set forth some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would **lead** that individual to combine the relevant teachings of the references." In re Fritch, 23 USPQ 2d 1780, 1783 (Fed. Cir. 1992).

In addition, the Office Action is essentially arguing that it would have been obvious to one skilled in the art to try several different modifications, ultimately resulting in the claimed feature. However, an "obvious to try" rationale for modifying a reference is not valid motivation

under 35 USC §103. In re Goodwin, 576 F.2d 375, 377, 198 USPQ 1, 3 (CCPA 1978); In re Antonie, 559 F.2d 618, 195 USPQ 6 (CCPA 1977); In re Tomlinson, 363 F.2d 928, 150 USPQ 623 (CCPA 1966).

Regarding claims 8-11, the Office Action merely sets forth that it would have been obvious to modify the purported combination "with the above holographic lens teachings from Kajiyama et al., motivation is to provide for the appropriate holographic lens to project the light beams onto the record medium." The Office Action has failed to provide any support for where such a motivation has been derived, or why the aforementioned purported combination would need or even desire the specific features disclosed in Kajiyama et al. ✓

The Office Action is attempting to rebuild the present invention piece by piece. Where applicants had provided reasoned arguments in the application for particular features and particular arrangements, the Office Action has combined features from multiple references and merely argued that there combination would have been obvious to make the system operate properly. However, only the present application has provided the necessary support for such combinations or modifications.

For at least the above, it is respectfully requested that this rejection be withdrawn.

CONCLUSION:

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

Serial No. 09/442,095

Docket No.: 1349.1016 (STB)

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

Date:

2/27/03

By:


Stephen T. Boughner
Registration No. 45,317

700 Eleventh Street, NW, Suite 500
Washington, D.C. 20001
(202) 434-1500